

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES J. FINLEY
and
MEHRAN ARBAB

Appeal No. 1998-1663
Application No. 08/508,408

HEARD: January 24, 2001

Before JOHN D. SMITH, WARREN, and DELMENDO, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Pursuant to the provisions of 37 CFR § 1.197(b) (1997), the appellants have submitted a request for rehearing of our decision entered February 20, 2001, in which we affirmed the examiner's rejection of appealed claims 9 and 10 under 35 U.S.C. § 103 but reversed the rejection of appealed claims 2 through 8, 23 through 28, and 30 through 44 under the same ground.

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The appellants argue as follows:

The above step [i.e., the sputtering step of appealed claim 9] clearly recites that the titanium film is sputter deposited and that the sputter deposited film is a metal film. After the titanium film is deposited, the oxidizing step is practiced. Clearly claim 9 recites that the step of sputtering and the step of oxidizing are separate steps. In its broadest reading the "sputtering and oxidizing steps" of claim 9 are not conducted in one step. [Request for rehearing, p. 2.]

The appellants then submit as follows:

Finley as read by the Board teaches sputtering to deposit a titanium oxide film. Applicants' claim 9 as discussed above covers sputtering to deposit a titanium film and thereafter, oxidizing the deposited film.

Based on the above, applicants respectfully submit that Finley teaches depositing a metal oxide film; Khanna also teaches depositing a metal oxide film. An artisan combining Khanna and Finley would deposit a metal oxide film. Applicants' claims 9 and 10 on the other hand recite that an amorphous titanium film, more particularly a metal amorphous titanium film, is deposited, and thereafter the film is oxidized. [Id. at pp.2-3.]

We cannot agree. As we stated in our original decision (page 6), appealed claim 9, unlike claim 31, does not recite that the deposition of the film is operated below the "switch point." Nor is there any recitation in claim 9 that the deposition is conducted in the "metallic mode" as described in the present specification. Although the appellants urge that the recited oxidizing step is practiced after the titanium film is deposited, appealed claim 9 does

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not preclude the sputtering of a titanium film and the oxidation of the film in one step. This is exactly what occurs in Finley or Khanna.

In addition, appealed claim 9 does not recite the term "after" or "thereafter" as the appellants seem to think. In re Morris, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997) ("It is the applicants' burden to precisely define the invention, not the PTO's. ").

According to the appellants' specification, "[t]he amount of reactive gas is kept sufficiently low so that the sputtering mode is essentially metallic, and the film deposited is essentially metallic." (Underscoring added; page 14.) The term "essentially" would indicate to one skilled in the relevant art that in the broadest reasonable interpretation of appealed claim 9, the film deposited by sputtering includes not only purely metallic but also metal oxide films. Where the film deposited by sputtering is a metal oxide, the oxidizing step would have occurred during the sputtering step as in Finley or Khanna. In our view, the use of the term "titanium film" as it appears in appealed claim 9 is purely a matter of semantics, as one skilled in the relevant art would understand

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this term in its broadest context to actually include titanium oxide layers deposited in a "slightly oxidizing atmosphere" as described in Finley or about 28% reactive gas as described in Khanna.

The appellants have proposed amending appealed claim 9 to positively recite that the deposited film is a "titanium metal film" and that the sputtering and oxidizing steps are separately conducted, in the event that we agree appealed claim 9 "inherently recites" these limitations. (Request, page 3.) However, 37 CFR § 1.197(b) does not provide for such a proposal to amend appealed claim 9 at this stage. Therefore, it is not appropriate. Further, we do not agree with the appellants that the limitations are "inherently" recited in appealed claim 9. Quite oppositely, we find that the appellants' conditional proposal to amend further supports our determination that appealed claim 9 is significantly broader in scope than that argued by the appellants.

In summary, we have reconsidered our decision in light of all of the arguments made in the appellants' request. However, we see no compelling reason justifying a different result. Accordingly, we decline to modify our original decision.

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No time period for taking any subsequent action in connection
with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

JOHN D. SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES F. WARREN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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ROMULO H. DELMENDO)	
Administrative Patent Judge)	

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